

Remarks

Applicants respectfully request reconsideration of the present U.S. Patent application as amended herein. Claim 1 has been amended. No claims have been added or canceled. Thus, claims 1-16 are pending.

CLAIM REJECTIONS – 35 U.S.C. § 112, SECOND PARAGRAPH

Claim 1 was rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Specifically, the Office Action states:

Regarding claim 1, the phrase “may be” renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by “or the like”), thereby rendering the scope of the claim(s) unascertainable.

See page 2. Claim 1 has been amended to remove the phrase “may be.” Accordingly, Applicants submit that the rejection of claim 1 as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention has been overcome.

CLAIM REJECTIONS – 35 U.S.C. § 103(a)

Claims 1-16 were rejected as being unpatentable over U.S. Patent No. 6,427,168 issued to McCollum (*McCollum*) and Smart Technology Enablers “SmartCIM™ to DMI Mapper” (*Smart*). Specifically, the Office Action states:

Regarding claims 1-16, McCollum discloses a method apparatus and a computer program for, CIM clients to communicate request response between CIM client and proxy CIMOM, (Fig. 3). McCollum does not explicitly teach use of CIM-DMI for interfacing between CIMOM and DMI application, but suggested that vendors’ specific protocol such as DMI can be used for such communication (Col.5, line 59,

Col.6, line 1.2). However, in an analogous art, Smart teaches “SmartCIM™ to DMI Mapper”, which *could* be used to interface between CIMOM for translating request, response, interrupt or other desirable communications between CIM and DMI (see whole document). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate Smart teaching with McCollum to enhance system efficiency.

See page 3 (emphasis added).

Applicants point out that something in the prior art must suggest the desirability, and thus the obviousness, of making the combination proposed in the Office Action. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434, 1438 (CAFC 1988). Although an Office Action may suggest that an element of a reference *could* be modified in view of a secondary prior art reference to form the claimed structure, the mere fact that the prior art *could* be so modified would not make the modification obvious unless the prior art suggested the desirability of the modification (emphasis added). *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1297 (CAFC 1989). There must be some supporting teaching in the prior art for the proposed combination of references to be proper. *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (CAFC 1989). No such teaching or suggestion has been provided in the Office Action.

Applicants are concerned that the references have been combined with the benefit of hindsight, which must be avoided in combining reference elements. *Panduit Corp v. Dennison Manufacturing Co.*, 774 F.2d 1082, 227 USPQ 337, 343 (CAFC 1985); *In re Find*, 837 F.2d 1071, 5 USPQ2d 1596 (CAFC 1988). It is error to reconstruct a patentee's claimed invention from the prior art by using the patentee's claim as a blueprint. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (CAFC 1983), *cert. denied*, 469 U.S. 851 (1984). “When prior art references require

selective combination . . . to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight obtained from the invention itself."

Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 227 USPQ 543, 551 (CAFC 1985).

Applicants submit that the reason for combination set forth in the Office Action (i.e., "to enhance system efficiency") is insufficient because it is not based on any passage in the cited references.

Moreover, MPEP § 2131 states:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

A claim rejection violates 35 U.S.C. § 132 if it "is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection." *Chester v. Miller*, 906 F.2d 1574, 1578, 15USPQ2d 1333, 1337 (Fed. Cir. 1990). Thus, 35 U.S.C. § 132 requires that an Office Action include the reasons for any rejection of any claim.

In the Office Action, the Examiner has failed to explicitly show that each and every element as set forth in each of the rejected claims is taught or suggested by the cited references; therefore a *prima facie* case of obviousness has not been made. The Office Action simply provides a general characterization of an approximation of claim 1 and applies this characterization to all of the claims. Applicant therefore respectfully requests that the Examiner explicitly specify, for each rejected claim, where each and

every element of the claim is taught or suggested by the cited references or allow the claims.

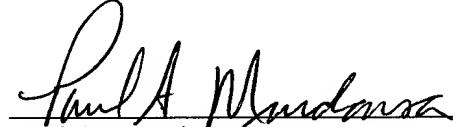
CONCLUSION

For at least the foregoing reasons, Applicants submit that the rejections have been overcome. Therefore, claims 1-16 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application.

Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP

Date: Aug 6, 2004



Paul A. Mendonsa
Attorney for Applicant
Reg. No. 42,879

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025-1026
(503) 439-8778